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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,852	03/30/2001	Haruhiko Kishi	205041US-6	7025

22850 7590 01/19/2006

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EXAMINER

TRAN, ELLEN C

ART UNIT PAPER NUMBER

2134

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,852

Applicant(s)

KISHI ET AL.

Examiner

Ellen C. Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication: amendment filed 15 December 2005, with an original application filed 30 March 2001, with acknowledgement of foreign application filing date of 30 March 2000.
2. Claims 1-20 are currently pending in this application. Claims 1, 10, 19, and 20 are independent claims. Claims 1, 2, 3, 4, 8, 10, 11, 12, 13, 17, 19, and 20 have been amended.
3. Amendments to the claims are accepted.

Response to Arguments

4. Applicant's arguments with respect to claims 1-20 have been considered but have not been found persuasive. The previous rejection has been amended to account for modifications to the claims.

As indicated in the Advisory Action mailed 15 November 2005, the only limitation that the cited reference Downs et al. US Patent No. 6,22,618 (hereinafter '618) does teach is the authentication of the portable medium prior to writing a purchase selection onto authenticated portable medium. It is noted that all the independent claims have been amended to incorporate this feature. In addition the below rejection includes Kawamae et al. US Patent No. 6,778,757 (hereinafter '757) that teaches this feature, see '757 col. 4, line 56 through col. 5, line 3.

In response to applicant's argument on page 10, "Conversely in an exemplary embodiment of the Applicant's invention, content is selected from a list of available content by a user via a vending apparatus ... Upon authentication that a portable recording medium is loaded to a vending apparatus employs a license management capability". The Office notes the

"vending apparatus" is interpreted to have the same meaning as the Clearinghouse(s) computer or cluster of computer that provide the requested content through the Internet or other network. The authentication of the portable recording medium is taught in '757 col. 4, line 56 through col. 5, line 3.

In response to applicant's argument beginning on page 10, "As can be appreciated, the decryption keys provided from the clearing house(s) are not provided based upon the authentication that a portable recording medium is loaded to a vending apparatus and the portable recording medium employs a license management capability ... The ability of Applicants' vending apparatus to authenticate a recording medium prior to loading content and encryption keys to the recording medium enables the Applicants' vending device to ensure that content provided from the device cannot be subsequently copied". As stated above this is overcome by the '757 reference.

In response to applicant's argument on page 11, "Down does not disclose or suggest authenticating a portable recording medium loaded to a vending apparatus". The Office agrees but this limitation is taught by '757.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Down et al. US Patent No. 6,226,618 (hereinafter '618) in further view of Kawamae et al. U.S. Patent No. 6,778,757, (hereinafter '757).

As to independent claim 10, "An information vending method comprising the steps of" is taught in '618 col. 1, lines 51-56;

"accumulating information for sale" is shown in '618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

"generating usage conditions in response to a purchase selection of the information for sale; encrypting said purchase selection; generating a cryptographic key which decrypts said purchase selection" is disclosed in '618 col. 50, line 33 through col. 52, line 32;

the following is not taught in '618: **"authenticating a license management capability of recording medium loaded on said information vending apparatus in one of direct and indirect manners; and writing said purchase selection to said portable recording medium authenticated in the authentication step along with said usage conditions for said license management capability and said cryptographic key"** however '757 discloses "The DVD-RAM drive 15 includes a compliance mark detection unit 24, an authentication unit #2 (25) and a CSS authentication unit 27. The authentication unit #2 (25) authenticates the input and output devices, i.e. the MPEG encoder at the time of recording and the MPEG decoder at the time of reproduction. The CGS 26 records the duplication generation management information on the disk. The compliant mark detection unit 24 records the compliant mark for indicating that the DVD-RAM drive is a compliant device at the time of recording. At the time of reproduction, on the other hand, the compliant mark detection unit 24 detects a compliant mark which is recorded

if the device that has recorded the data in the disk is compliant. In the case where such a mark cannot be detected, the reproduction operation is not performed.” in col. 4, line 56 through col. 5, line 5.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a method for securely distributing data taught in ‘618 to include a means to authenticate a recording medium prior to copying data. One of ordinary skill in the art would have been motivated to perform such a modification to prevent illegal copying of data see ‘757 (col. 1, lines 42 et seq.) “With the devices such as the DVD-RAM drive which includes digital/analog input/output means, however, it is difficult to prevent illegal duplication with these techniques alone. Such techniques are even sometimes easily avoided. Also, data exchange within the personal computer is more complicated, often generating a loophole of duplication control”.

As to dependent claim 11, “further comprising communicating with a reproduction unit for reproducing said purchase selection recorded on said portable recording medium; wherein in said authentication step, said reproduction unit is further authenticated when in said communication step said reproduction unit is communicated; and in said writing step, said encrypted information for sale along with said usage conditions and said cryptographic key are written to said recording medium through said reproduction unit” is taught in ‘618 col. 7, line 40 through col. 8, line 5.

As to dependent claim 12, “wherein said reproduction unit is a portable device and said portable medium being detachably loaded on said portable device” is shown in ‘618 col. 11, lines 29-53.

As to dependent claim 13, “wherein in said communication step, said reproduction unit which reproduces said purchase selection recorded on said portable recording medium integrally disposed on said reproduction unit is communicated; and in said writing step, said encrypted purchase selection along with said usage conditions and said cryptographic key are written to said portable recording medium integrally disposed on said reproduction unit” is disclosed in ‘618 col. 7, lines 11-65.

As to dependent claim 14, “wherein said reproduction unit is a portable device and said storage medium is fixedly and integrally arranged on said portable device” is taught in ‘618 col. 6, lines 37-48.

As to dependent claim 15, “further comprising: receiving said information for sale supplied through a predetermined transmission path; wherein in said accumulation step, said information received by said receiving means is accumulated” is shown in ‘618 col. 26, line 35 through col. 27 line 18.

As to dependent claim 16, “wherein said transmission path is the Internet, said information is supplied via the Internet to a server unit, and said information is received from said server unit to be stored in said accumulation step” is disclosed in ‘618 col. 26, line 35 through col. 27 line 18.

As to dependent claim 17, “wherein in said usage condition generating step, said usage conditions which are employed by said reproduction unit which reproduces said purchase selection recorded on said portable recording medium are generated; and in said encryption step, said purchase selection is accessed by use of an algorithm which allows

said reproduction unit to decrypt said purchase selection” is taught in ‘618 col. 7, lines 11-55.

As to dependent claim 18, “wherein said information for sale includes at least one of program, voice, music, still picture, moving picture, text data” is shown in ‘618 col. 1, lines 50-57.

As to independent claim 1, this claim is directed to the apparatus of the method of claim 10 and is rejected along similar rationale.

As to dependent claims 2-9, these claims are substantially similar to claims 11-18 and are rejected along the same rationale.

As to independent claim 19, this claim is directed to a program storage medium of the method of claim 10 and is rejected along similar rationale.

As to independent claim 20, “An information vending apparatus comprising” is taught in ‘618 col. 1, lines 51-56;

“an accumulation unit configured to accumulate information for sale” is shown in ‘618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

“a usage condition generating unit configured to provide usage condition for said information for sale in response to a purchase selection of information for sale; an encryption unit configured to encrypt said purchase selection” is disclosed in ‘618 col. 50, line 33 through col. 52, line 32;

“an encryption key generating unit configured to generate a cryptographic key which decrypts said purchase selection” is disclosed in ‘618 col. 6, line 65 through col. 7, line 65;

“an authentication unit configured to authenticate a portable recording medium directly or indirectly loaded on said information vending apparatus; and a writing unit configured to write said purchase selection to said portable recording medium authenticated by said authentication means along with said usage conditions and said cryptographic key” is taught in ‘757 col. 4, line 56 through col. 5, line 5.

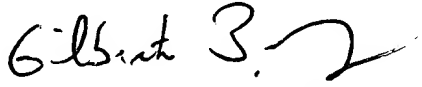
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ellen. Tran
Patent Examiner
Technology Center 2134
12 January 2006


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